REMARKS

Claims 1-34 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Objection to Claims 1, 13 and 29

Claims 1, 13 and 29 are objected to as it is alleged that an "integer altitude value" as recited in the subject claims does not find support in applicants' disclosure. In particular, the Examiner asserts that the claim aspect "integer altitude value" does not fall within the ambit of "a unique numerical value" as disclosed in the subject specification. In maintaining this objection, the Examiner states: "[t]he altitude of a minifilter can be a unique numerical value" (on page 7, lines 9-11), which does not include integer." (*See* Office Action dated January 26, 2006, page 4). It is truly perplexing to applicants' representative's mind how an integer (a natural number, such as, –100, –4, –3, –2, –1, 0, 2, 3, 4, 5, 100, 298, or 1000), that forms a countably infinite set, cannot fall within the purview of "a unique numerical value". It is submitted, contrary to the Examiner's assertions, that any whole number (a number that is neither a fraction nor a mixed fractional number) between $-\infty$ to ∞ could constitute an integer and fall within the scope of being a unique numerical value.

Additionally, it is noted that there is no *in haec verba* requirement associated with the interpretation and amendment of claims, all that is required is that the language of the claims be supported in the specification through express, implicit or inherent disclosure. It is thus submitted that the disclosure at page 7, lines 9-11 of applicants' specification would reasonably lead persons ordinarily skilled in the art to the inexorable conclusion that an integer value (a natural number or whole number) falls full square within the interpretive scope of a unique numerical value.

Further, the Examiner's statement that the "broadest interpretation of 'altitude integer value' in light of the specification 'unique numerical value' is float", (*See* Office Action dated January 26, 2006, page 4), is erroneous. By definition an integer is a whole number, it cannot be a floating-point number as the Examiner asserts. As stated above, integers comprise an infinite set of countable natural numbers (*e.g.*, non-fractional and

non-mixed fractional numbers) that extend from $-\infty$ to ∞; an integer by definition can only be numbers such as, for example, –1234, –1233, –1232, ..., –2, –1, 0, 1, 2, 3, 4, ..., 10000, 10001, *etc.* Thus it is contended that the broadest possible interpretation of an "integer altitude value" is an integer, not a floating-point number as the Examiner contends.

Moreover, claims must be interpreted in light of the specification, but limitations from the specification are not to be read into the claims. (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993); *see also*, *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim.") and *E-Pass Techs., Inc. v. 3Comm Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."). Additionally, while applicants' representative is cognizant that during patent examination, pending claims must be given their broadest reasonable interpretation consistent with the specification, (*see e.g.*, *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)), the broadest reasonable interpretation of the claims must nevertheless also be consistent with the interpretation that those in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In view of the foregoing it is applicants' representative's contention that the Examiner is impermissibly reading limitations from the specification into the claims where such limitations would not be consonant with the understanding of one of ordinary skill in the art. Accordingly, withdrawal of this objection with respect to claims 1, 13 and 29 is respectfully requested.

II. Rejection of Claims 1 and 3-34 Under 35 U.S.C. §101

Claims 1 and 3-34 stand rejected under 35 U.S.C. §101 as the Examiner alleges the subject claims are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. Withdrawal of this rejection is requested for at least the following reasons. The subject claims recite one or more useful, concrete and tangible results.

Independent claims 1, 13, and 29 each produce one or more useful, concrete and tangible results. Independent claim 1 recites: ***a computer system that facilitates management of a file system filter, comprising: at least one minifilter that has an integer altitude value associated therewith; and a filter manager that maps altitudes of the at least one minifilter to legacy filter order groups***. As such, independent claim 1 provides a computer system that facilitates management of a file system filter. In addition independent claim 1 provides that in order to facilitate management of the file system filter that a filter manager maps integer altitude values associated with at least one minifilter to legacy filter order groups. Each of the aforementioned results with respect to independent claim 1 are useful, concrete and tangible, as such results allow the coexistence between legacy filters that are already part of a file system and newer filters, thus mitigating the necessity for developers of legacy filters to perform substantial modification on the these legacy filters in order to ensure they can coexist with newer filters.

Additionally, independent claim 13 recites: a computer implemented method for managing a file system filter, comprising: loading at least one minifilter to a file system; and determining an integer altitude value associated with the at least one minifilter. As is apparent, the subject claim, like independent claim 1, recites useful, concrete and tangible results, namely, a computer-implemented method for managing a file system filter, loading at least one minifilter to a file system, and determining an integer altitude value associated with the at least one loaded minifilter.

Further, independent claim 29 recites one or more useful concrete and tangible results, namely: mapping integer value altitudes of minifilters to legacy filter order

groups, and determining an altitude interval associated with at least one frame, thereby facilitating management of a file system filter.

Moreover, in the instant Office Action the Examiner appears to be under the misapprehension that 35 U.S.C. §101 requires the claims to contain limitations to practical applications in the technological arts. Appellants' representative disagrees. United States patent law has never supported the application of a "technological aspect" or "technological arts" requirement. Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the "technological arts" to be patentable. Section 101 of Title 35 recites "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore ..." Accordingly, while an invention must be "new" and "useful," there is no statutory requirement that it fit within a category of "technological arts." Moreover, while there has been some judicial discussion of the expression "technological arts" and its relationship to patentability, this dialogue has been limited and its viability questioned. In 1970, the Court in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970) introduced a standard for evaluating process claims under Section 101: any sequence of operational steps is a patentable process so long as it is within the technological arts so as to promote the progress of useful arts. While a few subsequent courts have made reference to this so-called "technological arts" standard, the Supreme Court in *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972) refused to adopted this standard when it reversed the Court of Customs and Patent Appeals decision in the aforementioned case. Moreover, the Court of Customs and Patent Appeals effectively rejected the technological arts test in *In re Toma*, 575 F.2d 872, 878, 197 USPQ 852, 857 (CCPA 1978), by strongly suggesting that *Musgrave* was never intended to create a technological arts test for patent eligibility:

> The language which the examiner has quoted [from *Musgrave* and its progeny relating to "technological arts"] was written in answer to "mental steps" rejections and was not intended to create a generalized definition of statutory subject matter. Moreover, it was not intended to form a basis for a new § 101 rejection as the examiner apparently suggests. *In re Toma*, 575 F.2d at 878, 197 USPQ at 857.

Moreover, the "technological arts" consideration is completely devoid from recent Federal Circuit cases like *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, (Fed. Cir. 1999), and *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998).

It is submitted that the "technological arts" requirement propounded by *Musgrave* should be confined to its facts and holding, *i.e.*, that the computer-related invention in dispute was a patentable invention within the meaning of Section 101 because it was an advancement in technology which clearly promoted the useful arts. Thus, the decision in *Musgrave* should not be construed as a "technological arts" requirement for patentability, but rather as a proposition that computer-implemented process claims might be patentable subject matter.

Further, in *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005), the Board rejected the Examiner's argument that *Musgrave* and *Toma* created a technological arts test. "We do not believe the court could have been any clearer in rejecting the theory the present examiner now advances in this case." *Lundgren*, at 8. The Board held that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." *Lundgren*, at 9. Thus, in view of the foregoing it is evident that there are no recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas.

In view of at least the foregoing, it is apparent that applicants' claimed invention produces a useful, concrete and tangible result pursuant to *AT&T Corp. v. Excel Communications, Inc.*, and the Examiner's contention that the subject claims must be limited to a practical application within the technological arts lacks support from either 35 U.S.C. §101 or the Federal Courts' precedential interpretation thereof. Accordingly, withdrawal of this rejection with respect to independent claims 1, 13, and 29, and associated dependent claims, is respectfully requested.

III. Rejection of Claims 1 and 3-34Under 35 U.S.C. §102(e)

Claims 1 and 3-34 stand rejected under 35 U.S.C. 102(e) as being anticipated by Golds *et al.* (US 2001/0020245 A1). Withdrawal of this rejection is requested for at least the following reasons. Golds *et al.* does not disclose all aspects recited in the subject claims.

> A single prior art reference anticipates a patent claim only if it ***expressly or inherently describes each and every limitation set forth in the patent claim.*** *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The ***identical invention must be shown in as complete detail as is contained in the ... claim.*** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed subject matter relates to legacy filter support in a new managed file system filter model, and in particular, to systems and methods that facilitate ordering of file systems and file system filters. Independent claim 1 (and similarly, independent claims 13 and 29) recites: *at least one minifilter that has an integer altitude value associated therewith.* Golds *et al.* does not disclose or suggest this particular aspect of the claimed subject matter.

Golds *et al.* discloses a system and method for ordering software modules in a guaranteed order for execution wherein unique ordering values are statically assigned to software modules. The Examiner contends that the cited document discloses the pertinent aspect of the subject claims at page 4, paragraphs 0033 and 0035. Page 4, paragraph 0033 provides for the assignment of ordering values to drivers, wherein the drivers, based on their functionality, are grouped into classes such that within each class various rules can be employed to assign ordering values to the drivers. Page 4, paragraphs 0035-0036 further provides that once classified into a group, each driver is given an ordering value in a range based on its class type that is a floating-point value. The ordering value taking the form of 0.ABBB, where the first character identified by "A" is employed to define a general class or family of driver types, and the characters "BBB" are utilized to order individual drivers within the general class of driver types.

The claimed subject matter in contrast, employs and assigns integer values to facilitate ordering of file systems and file system filters, rather than assigning floating point values to software modules. It is thus clearly apparent that applicants' claimed subject matter and the cited document are distinguishable. Accordingly, withdrawal of this rejection with respect to independent claims 1, 13 and 29 (and claims that depend there from) is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP530US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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